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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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NGUYEN, MADELEINE ANH VINH

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* TETSURO MOTOYAMA

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Appeal 2008-0267  
Application 09/108,705  
Technology Center 2600

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Decided: June 9, 2008

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Before JOSEPH F. RUGGIERO, JOHN A. JEFFERY, and CARLA M.  
KRIVAK, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from the Final Rejection of  
claims 37-48 and 70-77. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

Appellant's claimed invention relates to the remote monitoring, diagnosis, and control of machines which utilize multiple communication formats. Various portions of a received communication are analyzed to determine which communication protocol is being used. (Specification 2-5, generally).

Claim 37 is illustrative of the invention and reads as follows:

37. A method of diagnosing a first device by a second device which has an ability to diagnose different types of devices including different business office devices, comprising the steps of:

transmitting, through a communication channel, first information from the first device to the second device;

receiving, by the second device, the first information which has been transmitted;

determining, by the second device, second information utilized by the first device, wherein the second information is a first portion of the first information;

parsing, by the second device, a second portion of the first information transmitted by the first device using the second information which has been determined to determine a format of the second portion whereby the second portion is parsed, wherein the second portion is different from the first portion; and

diagnosing a condition of the first device by the second device using the second portion which has been parsed.

The Examiner relies on the following prior art references to show unpatentability:

Hemmady	US 4,872,157	Oct. 3, 1989
Allen	US 5,394,458	Feb. 28, 1995

Claims 37-48 and 70-77, all of the appealed claims, stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Allen in view of Hemmady.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Briefs and Answer for the respective details. Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived [see 37 C.F.R. § 41.37(c)(1)(vii)].

## ISSUE

Under 35 U.S.C. § 103(a), with respect to appealed claims 37-48 and 70-77, would one of ordinary skill in the art at the time of the invention have found it obvious to combine Allen and Hemmady to render the claimed invention unpatentable?

## PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). “[T]he examiner bears

the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Furthermore, “‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

#### ANALYSIS

With respect to the Examiner’s 35 U.S.C. § 103(a) rejection of appealed independent claims 37, 43, and 74 based on the combination of Allen and Hemmady, Appellant asserts that the Examiner has failed to set forth a *prima facie* case of obviousness since a proper basis for the proposed combination of references has not been established. After reviewing the arguments of record from Appellant and the Examiner, we are in general agreement with Appellant’s position as stated in the Briefs.

The Examiner proposes to modify the reproduction device diagnostic system disclosure of Allen by adding the communication format determination feature disclosed by Hemmady. According to the Examiner (Ans. 8), the skilled artisan would have combined the teachings of Hemmady with Allen since Allen discloses, as does Hemmady, the use of different protocols in the transmission of data through different communication lines.

We agree with Appellant (App. Br. 7-8; Reply Br. 2-3), however, that Hemmady, at best, only provides a disclosure that when various end user systems using multiple communication protocols communicate over a single telecommunications network, protocol identifiers are utilized to determine the proper communication message format. We also agree with Appellant (*id.*) that the system of Allen, which utilizes only a single communication format for a specific communication line, would have no need and derive no benefit from the communication format determination teachings of Hemmady.

In other words, Allen has no need for a communication format determination procedure since the communication format is determined by the particular communication line chosen for communication. As described by Allen (col. 3, ll. 24-62), when direct communication through an RS-232 interface 3 is selected, a standard RS-232 communication protocol is utilized, and when communication over a standard telephone line is chosen, a format provided by telecommunication modem 4 is utilized.

In view of the above discussed deficiencies in the applied prior art, we fail to see how and in what manner the disclosure of Allen might have been modified by Hemmady to arrive at the features set forth in each of the appealed independent claims. In our view, given the disparity of problems addressed by the applied prior art references, and the differing solutions proposed by them, any attempt to combine them in the manner proposed by the Examiner could only come from Appellant's own disclosure using hindsight reconstruction. Further, although Hemmady arguably discloses the header information parsing and format determination feature of the appealed claims, there is no indication in the disclosure of Hemmady, as

pointed out by Appellant (Reply Br. 3), that the parsing and diagnosing operations are performed by the same device as claimed.

In view of the above discussion, we are of the opinion that the applied prior art references, even if combined, do not support the obviousness rejection. We, therefore, do not sustain the Examiner's 35 U.S.C. § 103(a) rejection of independent claims 37, 43, and 74, nor of claims 38-42, 44-48, 70-73, and 75-77 dependent thereon.

### CONCLUSION

In summary, we have not sustained the Examiner's 35 U.S.C. § 103(a) rejections of any of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 38-47 and 70-77 is reversed.

REVERSED

gvw

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